

## II. Rejection of Claims 20, 23-27 and 29 Under 35 U.S.C. Section 103(a).

In the January 16, 2003 Office action, the Examiner rejected claims 20, 23-27, and 29 under 35 U.S.C. 103(a) as being unpatentable over Masaki, Japanese Patent No. 09-244,385 (hereinafter "Masaki"), in view of Gunn, U.S. Patent No. 5,308,121 (hereinafter "Gunn"). For the following reasons, reconsideration is respectfully requested.

In the Office action, the Examiner rejected Claims 20, 23-27 and 29 on the grounds that Masaki discloses a multiple service card associated with a service partner, a primary party, and a holder, the card comprising a first side and a second side, the first side having indicia associated with the primary party, the second side having indicia associated with the service partner. The Examiner admits that Masaki fails to teach or fairly suggest that the primary party is a provider of credit services and the service partner is a provider of membership club services. The Examiner asserts, however, that Gunn teaches the above limitations by offering a combination of services used with a credit card. The Examiner contends that it would have been obvious to an artisan of ordinary skill in the art to incorporate the teachings of Gunn into the teachings of Masaki to produce Applicants' claimed invention.

With regard to the §103 rejections of Claims 20, 23-27, and 29, "[i]t is impermissible to first ascertain factually what [Applicants] did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct [Applicants'] invention from such prior art." *In re Shuman*, 361 F.2d 1008, 1012 (C.C.P.A. 1996). The present claims, as amended, define an invention that is not obvious over Masaki or Gunn, taken singularly or in combination. The Office has not identified any reference, either singularly or in combination, that teaches, hints, suggests, or discloses the specific combination recited in the claims. Applicants respectfully submit that a *prima facie* case of obviousness has not been made out by the Examiner because Masaki and Gunn fail to disclose every element appearing in claims 20, 23-27, and 29.

Specifically, Applicants have amended claim 20 to clarify that credit card application information is received by the service partner and communicated to a provider of credit services, and that the primary party provider of credit services thereafter determines, after considering the credit card application information that was previously received by the service partner and communicated to the primary party, whether or not the primary party desires to extend credit to the consumer. These functions are very complex and involve extensive hardware and software integration in order to allow two very different entities to communicate such information. Applicants respectfully submit that these amendments find full support in the claims, specification, or drawings as filed. This claimed structure is distinct over the cited references for at least the following reasons.

As discussed above, neither Masaki, Gunn nor any of the other cited references, alone or in combination, discloses, teaches, or suggests a system or method for providing a multiple service card wherein credit card application information is received by a service partner and then communicated to a provider of credit services, or that the primary party provider of credit services thereafter determines, after considering the credit card application information that was previously received by the service partner and communicated to the primary party, whether or not the primary party desires to extend credit to the consumer. As disclosed at page 4 of the present specification, however, "the present invention enables a single card to function in multiple modes, for example as both a credit card and a separate service partner's membership card." The present invention accomplishes this benefit "[b]y providing a system of back-end functionality that takes advantage of cooperation between the multiple service providers." This back-end functionality is implemented through extensive logic that performs a combination of appropriate process steps, implemented through complex software and hardware, as described in great detail between pages 12 and 23 of the present application.

For example, as described therein, a new account process is initiated when a prospective card member submits application information to a service partner. This application information contains not only a request for a credit card and a membership card, and is not simply an

identification of an existing account, such as an account number, but comprises such additional information as is required in a typical credit application. This application information is sufficient to enable a provider of credit services *to consider* and, if appropriate, to decide whether or not it is desirable to extend credit to the applicant. As discussed above, such cooperation is beneficial because it is not typically desirable that the decision to extend credit be made unilaterally by only the service partner and it is further beneficial that the service partner be capable of receiving the application information directly from the consumer. Moreover, such cooperation enables considered decision-making by the primary party while also enabling the service partner to offer the potential for credit services to be provided in conjunction with its membership card. Thus, it is advantageous to provide a means for communication and cooperation, for example, between the primary party provider of credit services and the service partner provider of membership club services so as to enable the primary party provider of credit services *to decide* whether or not it is desirable to extend credit to the potential holder of the card and, based on that decision, to affect the system and method accordingly. For this reason, Applicants' invention provides for communication of credit card *application* information to a provider of credit services to enable the provider of credit services to thereafter determine, by considering credit card application information, which was previously received by a service partner and communicated to a primary party, whether or not it desires to extend credit to the consumer. Moreover, the present system does not require the primary party to be enabled to unilaterally provide its credit card holders with access to the service partner's membership club services.

Moreover, this back-end functionality enables an extensive series of process steps, implemented through complex software and hardware, to be performed to accomplish, among other things: (1) the retention of the service partner application information; (2) the extraction of appropriate credit application data; (3) the assignment of appropriate control number(s); (4) the forwarding of the credit application data to a primary party provider of credit services; (5) the evaluation and assessment of creditworthiness of the applicant; (6) the tracking of the application; (7) the return of an approval/declination decision; (8) the initiation of an account and

its associated processing, statementing, billing, accounting, and servicing functions; (9) the sending of a multiple service card to the applicant; and the like. To implement this back-end functionality so as to accomplish these, and other, steps requires an extensive set of program instructions not taught or even suggested by the prior art.

To the contrary, the systems and methods of the prior art make no provision to accommodate such a combination of interdependent process steps implemented through software and hardware so as to accomplish the benefits of the present invention. Notably, although Gunn discloses a credit card with expanded surface area so as to enable additional services to be provided thereon, Gunn does not disclose any mechanism or method through which decisions may be made as to whether to provide the credit and/or the membership club services, nor through which separate providers of such credit and membership club services may communicate *after receipt of application information* to accommodate such a mechanism or method. As a result, no system or method exists in the prior art that can effectively enable a provider of credit services and a provider of membership club services to cooperate so as to enable a single application received by either of the service providers to result in the provision of a multiple service card, where the multiple service card is configured to provide access to both membership club services and credit card services, *and wherein the decision to extend credit does not need to have been predetermined or alternatively to be made unilaterally by only the service partner.*

The system of the instant invention, on the other hand, does incorporate such back-end functionality, and it is this back-end functionality that enables beneficial cooperation between the service providers. Accordingly, Applicants' invention enables a multiple service card to be provided without requiring creditworthiness to have been predetermined and without requiring the credit provider to waive its ability to extend, or decline to extend, credit to the applicant. Such cooperation provides the advantage that the decision whether or not to extend credit may be made by the primary party provider of credit services *before* the multiple service card is provided. Thus, it is a substantial and novel advantage that the present invention provides communication of an application between the primary party provider of credit services and the

service partner provider of membership club services so as to enable the primary party provider of credit services *to decide, after considering credit card application information*, whether or not it is desirable to extend credit to the potential holder of the service partner's membership card.

Thus, even if the cited prior art references were combined, which Applicants argue there is no motivation to do except in hindsight, the combination would not produce Applicants' novel invention, and thus, cannot obviate it. Moreover, the Office action fails to identify where, in any of the cited prior art references, the suggestion exists that Masaki either should be or could be modified by the teachings in Gunn to achieve the present invention. Applicants were the first to recognize the advantage of receiving an application at a service partner establishment, where the application includes service partner information and credit card application information and wherein the credit card application information is communicated to a provider of credit services so that the provider of credit services may thereafter determine, after considering the credit card application information, whether or not it desires to extend credit to the consumer. The Office action has not met its burden in establishing a *prima facie case of obviousness*. Therefore, reconsideration and withdrawal of these rejections are respectfully requested.

In sum, neither Masaki, Gunn, nor any other cited reference discloses, teaches, hints, or suggests every element of claim 20, so the rejection of this claim, and the rejection of claims 23-27, and 29, which depend from claim 20, is improper.

### III. Rejection of claims 1-19 under 35 U.S.C. 103(a).

In the January 16, 2003 Office action, the Examiner rejected claims 1-19 under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,969,318, which issued October 19, 1999 to Mackenthun ("Mackenthun") in view of Gunn and Masuda, U.S. Pat. No. 5,569,897 ("Masuda"). For the following reasons, reconsideration is requested.

In the Office action, the Examiner admits that Mackenthun does not teach or fairly suggest that the provider of credit services determines whether it wishes to extend credit to the

consumer. The Examiner asserts, however, that Gunn teaches the above limitations by offering a combination of services to be used with the credit card. The Examiner contends that it would have been obvious to an artisan of ordinary skill in the art to incorporate the teachings of Gunn into the teachings of Mackenthun to produce Applicants' claimed invention.

The Examiner also admits that Mackenthun as modified by Gunn fails to teach the method of receiving at a service partner establishment an application and that the service partner information is related at least in part to membership in the service partner establishment. The Examiner asserts, however, that Masuda teaches the above limitation with its system in which a consumer fills out an application and submits it through a retail store service partner. The Examiner contends that it would have been obvious to an artisan of ordinary skill in the art to incorporate the teachings of Masuda into the teachings of Mackenthun and Gunn to produce Applicants' invention as described in claims 1-19. For the following reasons, Applicants respectfully traverse the Examiner's grounds for rejection. Applicants respectfully submit that the cited references do not teach, hint, suggest, or disclose the elements of the present invention as disclosed and claimed.

With regard to the §103 rejections of Claims 1-19, “[i]t is impermissible to first ascertain factually what [Applicants] did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct [Applicants'] invention from such prior art.” *In re Shuman*, 361 F.2d 1008, 1012 (C.C.P.A. 1996). The present claims, as amended, define an invention that is not obvious over Mackenthun, Gunn, or Masuda, taken singularly or in combination. The Office has not identified any reference, either singularly or in combination, that teaches, hints, suggests, or discloses the specific combination recited in the claims. Applicants respectfully submit that a *prima facie* case of obviousness has not been made out by the Examiner because Mackenthun, Gunn and Masuda fail to disclose every element appearing in claims 1-19.

Specifically, Applicants have amended claims 1, 6, and 12 to clarify that credit card application information is received by the service partner and communicated to a provider of

credit services, and that the primary party provider of credit services thereafter determines, after considering the credit card application information that was previously received by the service partner and communicated to the primary party, whether or not the primary party desires to extend credit to the consumer. Applicants respectfully submit that these amendments find full support in the claims, specification, or drawings as filed. This claimed structure is distinct over the cited references for at least the following reasons.

As discussed above, neither Mackenthun, Gunn, Masuda nor any of the other cited references, alone or in combination, discloses, teaches, or suggests a system or method for providing a multiple service card wherein credit card application information is received by a service partner and then communicated to a provider of credit services, or that the primary party provider of credit services thereafter determines, after considering the credit card application information that was previously received by the service partner and communicated to the primary party, whether or not the primary party desires to extend credit to the consumer. As disclosed at page 4 of the present specification, however, "the present invention enables a single card to function in multiple modes, for example as both a credit card and a separate service partner's membership card." The present invention accomplishes this benefit "[b]y providing a system of back-end functionality that takes advantage of cooperation between the multiple service providers." This back-end functionality is implemented through extensive logic that performs a combination of appropriate process steps, implemented through complex software and hardware, as described in great detail between pages 12 and 23 of the present application.

For example, as described therein, a new account process is initiated when a prospective card member submits application information to a service partner. This application information contains not only a request for a credit card and a membership card, and is not simply an identification of an existing account, such as an account number, but comprises such additional information as is required in a typical credit application. This application information is sufficient to enable a provider of credit services *to consider* and, if appropriate, to decide whether or not it is desirable to extend credit to the applicant. As discussed above, such

cooperation is beneficial because it is not typically desirable that the decision to extend credit be made unilaterally by only the service partner and it is further beneficial that the service partner be capable of receiving the application information directly from the consumer. Moreover, such cooperation enables considered decision-making by the primary party while also enabling the service partner to offer the potential for credit services to be provided in conjunction with its membership card. Thus, it is advantageous to provide a means for communication and cooperation, for example, between the primary party provider of credit services and the service partner provider of membership club services so as to enable the primary party provider of credit services *to decide* whether or not it is desirable to extend credit to the potential holder of the card and, based on that decision, to affect the system and method accordingly. For this reason, Applicants' invention provides for communication of credit card *application* information to a provider of credit services to enable the provider of credit services to thereafter determine, by considering credit card application information, which was previously received by a service partner and communicated to a primary party, whether or not it desires to extend credit to the consumer. Moreover, the present system does not require the primary party to be enabled to unilaterally provide its credit card holders with access to the service partner's membership club services.

Moreover, this back-end functionality enables an extensive series of process steps, implemented through complex software and hardware, to be performed to accomplish, among other things: (1) the retention of the service partner application information; (2) the extraction of appropriate credit application data; (3) the assignment of appropriate control number(s); (4) the forwarding of the credit application data to a primary party provider of credit services; (5) the evaluation and assessment of creditworthiness of the applicant; (6) the tracking of the application; (7) the return of an approval/declination decision; (8) the initiation of an account and its associated processing, statementing, billing, accounting, and servicing functions; (9) the sending of a multiple service card to the applicant; and the like. To implement this back-end functionality so as to accomplish these, and other, steps requires an extensive set of program instructions not taught or even suggested by the prior art.

To the contrary, the systems and methods of the prior art make no provision to accommodate such a combination of interdependent process steps implemented through software and hardware so as to accomplish the benefits of the present invention. Notably, although Gunn discloses a credit card with expanded surface area so as to enable additional services to be provided thereon, Gunn does not disclose any mechanism or method through which decisions may be made as to whether to provide the credit and/or the membership club services, nor through which separate providers of such credit and membership club services may communicate *after receipt of application information* to accommodate such a mechanism or method. As a result, no system or method exists in the prior art that can effectively enable a provider of credit services and a provider of membership club services to cooperate so as to enable a single application received by either of the service providers to result in the provision of a multiple service card, where the multiple service card is configured to provide access to both membership club services and credit card services, *and wherein the decision to extend credit does not need to have been predetermined or alternatively to be made unilaterally by only the service partner.*

The method of the instant invention, on the other hand, does utilize such back-end functionality, and it is this back-end functionality that enables beneficial cooperation between the service providers. Accordingly, Applicants' invention enables a multiple service card to be provided without requiring creditworthiness to have been predetermined and without requiring the credit provider to waive its ability to extend, or decline to extend, credit to the applicant. Such cooperation provides the advantage that the decision whether or not to extend credit may be made by the primary party provider of credit services *before* the multiple service card is provided. Thus, it is a substantial and novel advantage that the present invention provides communication of an application between the primary party provider of credit services and the service partner provider of membership club services so as to enable the primary party provider of credit services *to decide, after considering credit card application information*, whether or not it is desirable to extend credit to the potential holder of the service partner's membership card.

Thus, even if the cited prior art references were combined, which Applicants argue there is no motivation to do except in hindsight, the combination would not produce Applicants' novel invention, and thus, cannot obviate it. Moreover, the Office action fails to identify where, in any of the cited prior art references, the suggestion exists that Mackenthun either should be or could be modified by the teachings in Gunn or Masuda to achieve the present invention. Applicants were the first to recognize the advantage of receiving an application at a service partner establishment, where the application includes service partner information and credit card application information and wherein the credit card application information is communicated to a provider of credit services so that the provider of credit services may thereafter determine, after considering the credit card application information, whether or not it desires to extend credit to the consumer. The Office action has not met its burden in establishing a prima facie case of obviousness. Therefore, reconsideration and withdrawal of these rejections are respectfully requested.

In sum, neither Mackenthun, Gunn, Masuda nor any other cited reference discloses, teaches, hints, or suggests every element of claims 1, 6, and 12, so the rejection of these claims, and the rejection of claims 2-5, 7-11, and 13-19, which depend from claims 1, 6, and 12, is improper.

#### **IV. Rejection of claim 28 under 35 U.S.C. 103(a).**

In the January 16, 2003 Office action, the Examiner rejected claim 28 under 35 U.S.C. 103(a) as being unpatentable over Masaki as modified by Gunn in view of Blank, U.S. Pat. No. 6,089,611 ("Blank"). For the following reasons, Applicants respectfully traverse the Examiner's grounds for rejection. Applicants respectfully submit that the cited references do not teach, hint, suggest, or disclose the elements of the present invention as disclosed and claimed.

With regard to the §103 rejections of Claim 28, "[i]t is impermissible to first ascertain factually what [Applicants] did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct

[Applicants'] invention from such prior art." *In re Shuman*, 361 F.2d 1008, 1012 (C.C.P.A. 1996). The present claims, as amended, define an invention that is not obvious over Masaki, Gunn or Blank, taken singularly or in combination. The Office has not identified any reference, either singularly or in combination, that teaches, hints, suggests, or discloses the specific combination recited in the claims. Applicants respectfully submit that a *prima facie* case of obviousness has not been made out by the Examiner because Masaki, Gunn or Blank fail to disclose every element appearing in claim 28.

Specifically, as discussed above, Applicants have amended claim 20 to clarify that credit card application information is received by the service partner and communicated to a provider of credit services, and that the primary party provider of credit services thereafter determines, after considering the credit card application information that was previously received by the service partner and communicated to the primary party, whether or not the primary party desires to extend credit to the consumer. Applicants respectfully submit that these amendments find full support in the claims, specification, or drawings as filed. This claimed structure is distinct over the cited references for at least the following reasons.

As discussed above, neither Masaki, Gunn, Blank, nor any of the other cited references, alone or in combination, discloses, teaches, or suggests a system or method for providing a multiple service card wherein credit card application information is received by a service partner and then communicated to a provider of credit services, or that the primary party provider of credit services thereafter determines, after considering the credit card application information that was previously received by the service partner and communicated to the primary party, whether or not the primary party desires to extend credit to the consumer. As disclosed at page 4 of the present specification, however, "the present invention enables a single card to function in multiple modes, for example as both a credit card and a separate service partner's membership card." The present invention accomplishes this benefit "[b]y providing a system of back-end functionality that takes advantage of cooperation between the multiple service providers." This back-end functionality is implemented through extensive logic that performs a combination of

appropriate process steps, implemented through complex software and hardware, as described in great detail between pages 12 and 23 of the present application.

For example, as described therein, a new account process is initiated when a prospective card member submits application information to a service partner. This application information contains not only a request for a credit card and a membership card, and is not simply an identification of an existing account, such as an account number, but comprises such additional information as is required in a typical credit application. This application information is sufficient to enable a provider of credit services *to consider* and, if appropriate, to decide whether or not it is desirable to extend credit to the applicant. As discussed above, such cooperation is beneficial because it is not typically desirable that the decision to extend credit be made unilaterally by only the service partner and it is further beneficial that the service partner be capable of receiving the application information directly from the consumer. Moreover, such cooperation enables considered decision-making by the primary party while also enabling the service partner to offer the potential for credit services to be provided in conjunction with its membership card. Thus, it is advantageous to provide a means for communication and cooperation, for example, between the primary party provider of credit services and the service partner provider of membership club services so as to enable the primary party provider of credit services *to decide* whether or not it is desirable to extend credit to the potential holder of the card and, based on that decision, to affect the system and method accordingly. For this reason, Applicants' invention provides for communication of credit card *application* information to a provider of credit services to enable the provider of credit services to thereafter determine, by considering credit card application information, which was previously received by a service partner and communicated to a primary party, whether or not it desires to extend credit to the consumer. Moreover, the present system does not require the primary party to be enabled to unilaterally provide its credit card holders with access to the service partner's membership club services.

Moreover, this back-end functionality enables an extensive series of process steps, implemented through complex software and hardware, to be performed to accomplish, among other things: (1) the retention of the service partner application information; (2) the extraction of appropriate credit application data; (3) the assignment of appropriate control number(s); (4) the forwarding of the credit application data to a primary party provider of credit services; (5) the evaluation and assessment of creditworthiness of the applicant; (6) the tracking of the application; (7) the return of an approval/declination decision; (8) the initiation of an account and its associated processing, statementing, billing, accounting, and servicing functions; (9) the sending of a multiple service card to the applicant; and the like. To implement this back-end functionality so as to accomplish these, and other, steps requires an extensive set of program instructions not taught or even suggested by the prior art.

To the contrary, the systems and methods of the prior art make no provision to accommodate such a combination of interdependent process steps implemented through software and hardware so as to accomplish the benefits of the present invention. Notably, although Gunn discloses a credit card with expanded surface area so as to enable additional services to be provided thereon, Gunn does not disclose any mechanism or method through which decisions may be made as to whether to provide the credit and/or the membership club services, nor through which separate providers of such credit and membership club services may communicate *after receipt of application information* to accommodate such a mechanism or method. As a result, no system or method exists in the prior art that can effectively enable a provider of credit services and a provider of membership club services to cooperate so as to enable a single application received by either of the service providers to result in the provision of a multiple service card, where the multiple service card is configured to provide access to both membership club services and credit card services, *and wherein the decision to extend credit does not need to have been predetermined or alternatively to be made unilaterally by only the service partner.*

The system of the instant invention, on the other hand, does incorporate such back-end functionality, and it is this back-end functionality that enables beneficial cooperation between the

service providers. Accordingly, Applicants' invention enables a multiple service card to be provided without requiring creditworthiness to have been predetermined and without requiring the credit provider to waive its ability to extend, or decline to extend, credit to the applicant. Such cooperation provides the advantage that the decision whether or not to extend credit may be made by the primary party provider of credit services *before* the multiple service card is provided. Thus, it is a substantial and novel advantage that the present invention provides communication of an application between the primary party provider of credit services and the service partner provider of membership club services so as to enable the primary party provider of credit services *to decide, after considering credit card application information*, whether or not it is desirable to extend credit to the potential holder of the service partner's membership card.

Thus, even if the cited prior art references were combined, which Applicants argue there is no motivation to do except in hindsight, the combination would not produce Applicants' novel invention, and thus, cannot obviate it. Moreover, the Office action fails to identify where, in any of the cited prior art references, the suggestion exists that Masaki either should be or could be modified by the teachings in Gunn or Blank to achieve the present invention. Applicants were the first to recognize the advantage of receiving an application at a service partner establishment, where the application includes service partner information and credit card application information and wherein the credit card application information is communicated to a provider of credit services so that the provider of credit services may thereafter determine, after considering the credit card application information, whether or not it desires to extend credit to the consumer. The Office action has not met its burden in establishing a *prima facie* case of obviousness. Therefore, reconsideration and withdrawal of these rejections are respectfully requested.

In sum, neither Masaki, Gunn, Blank, nor any other cited reference discloses, teaches, hints, or suggests every element of claim 20, so the rejection of this claim, and the rejection of claim 28, which depends from claim 20, is improper.

**V. Conclusion**

In view of the foregoing, Applicants respectfully submit that all of the pending claims fully comply with 35 U.S.C. Section 112 and are allowable over the prior art of record. Accordingly, reconsideration of the application and allowance of all pending claims is earnestly solicited. The undersigned would welcome a telephone call at the telephone number listed below if such would advance prosecution of this application.

Respectfully submitted,

By:   
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